

Appl. No. 10/052,317  
Atty. Docket No. G-273ML (CP-1232)  
Amtr. Dated January 5, 2004  
Reply to Office Action of October 7<sup>th</sup>, 2003  
Customer No. 27752

### REMARKS

Claims 1-5 and 7-24 remain pending in the present application. Claims 1 and 2 were amended while Claim 6 was deleted. No new matter has been added. No additional Claim fee is due.

Claims 7-24 are withdrawn as being directed to a non-related invention set forth in the previous restriction requirement. Applicants reserve the right to file an application directed to these claims in the future. Claims 7-24 may be deleted upon the indication of allowable subject matter.

Claims 1-6 have been rejected under 35 U.S.C. §102(b) as anticipated or under 35 U.S.C. §103(a) as being unpatentable over DE 196 04 178. The Examiner contends that DE '178 discloses substituted phenol compounds in which when R<sub>3</sub> and R<sub>4</sub> are selected as H and R<sub>1</sub> is selected as C<sub>1</sub>-C<sub>3</sub> alkyl anticipate or at a minimum teach obvious the compounds as originally claimed in the present application. Applicants respectfully traverse this rejection.

Applicants claims, as amended and set forth above, claim the use of substituted amino-5-methyl phenols as dye ingredients for kerating fibers. The available range of claimed substitutions include C<sub>1</sub> to C<sub>5</sub> hydroxy alkyl, C<sub>3</sub> to C<sub>6</sub> cyclic ring as well as a CH<sub>2</sub>-Ar substitution. In contrast to Applicants' claimed invention, DE '178 teaches only alkyl substituted amino phenols. There is no teaching of a substitution beyond that of a C<sub>1</sub> to C<sub>4</sub> alkyl chain. Accordingly, Applicants claims as amended are not anticipated by the teachings of DE '178.

Nor are Applicants claims obvious to one of ordinary skill in the art. As the Examiner is well aware, in order to establish a prima facie case of obviousness there must be some motivation provided by the reference itself or the art in general to modify the invention. Thus, there must be some teaching to modify the substitutions clearly set forth in DE '178. However, in the present case such motivation simply does not exist. There is no disclosure or teaching that would provide sufficient motivation to one of ordinary skill in the art to modify the compounds in DE '178 to include the claimed C<sub>1</sub> to C<sub>5</sub> hydroxyalkyl, C<sub>3</sub> to C<sub>6</sub> cyclic ring or the CH<sub>2</sub>-Ar substitutions of Applicants claims. There is simply no suggestion that these substitutions would lead to any expectation of success based on the clear teachings of DE '178. Accordingly, Applicants claimed invention is both novel and unobvious over the prior art of record and in condition for allowance.

### Conclusion

In light of the remarks presented herein, Applicants' respectfully submit that Claims 1-5 are allowable over the prior art of record or any combination thereof. Reconsideration and

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reexamination are respectfully requested. In the event that issues remain prior to allowance of the noted claims, then the Examiner is invited to call Applicants' undersigned attorney to discuss any remaining issues.

Respectfully submitted,

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